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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,823	06/12/2002	Jonathan Griffin	SYN-128	9917

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SYNGENTA BIOTECHNOLOGY, INC.
PATENT DEPARTMENT
3054 CORNWALLIS ROAD
P.O. BOX 12257
RESEARCH TRIANGLE PARK, NC 27709-2257

EXAMINER

ROOKE, AGNES BEATA

ART UNIT PAPER NUMBER

1653

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,823

Applicant(s)

GRIFFIN ET AL.

Examiner

Agnes B Rooke

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8,12-14,36,41-44 and 48 is/are pending in the application.
- 4a) Of the above claim(s) 9-11,15-35,37-40,45,46 and 49-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,12-14,36,41-44 and 48 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Applicant's response to the examiner's office action in the reply filed on 01/10/2005 is acknowledged.

Claims 9-11, 15-35, 37-40, 45, 46, and 49-51 have been canceled as they are drawn to non-elected inventions. Claims 4, 5, 13, and 47 have been canceled as requested in the reply filed on 01/10/2005.

Claims 1-3, 6-8, 12, 14, 36, and 41-44 have been amended.

Claims 1-3, 6-8, 12-14, 36, 41-44, and 48 are currently under examination. This application claims priority from the PCT/GB00/022457, which claims foreign priority to the United Kingdom 9915215.9 filed on 06/29/1999, and 9930536.9 filed on 12/23/1999.

Rejections Withdrawn

35 USC § 101

The rejection of Claims 41-44 is withdrawn because the Applicant amended the claims to be in proper form for the method claims reciting steps involved in the process.

The rejection of Claims 1-3, 6-8, 12, 14, 36, 41-44, and 48 is withdrawn because the Applicant amended the claims to recite that the claimed protein is isolated.

Claim Rejections - 35 USC § 112, first paragraph

The rejection of Claims 12, 36, and 47 is withdrawn because the Applicant amended the claims to “an insecticidal CRY protein” and canceled the phrase: “further protein.”

Rejections Maintained

Claim Rejections - 35 USC § 112, first paragraph

The rejection of Claim 36 is maintained because examiner cannot search the “the FASTA opt score greater than 109.”

In the first office action examiner stated that Claim 36 refers to FASTA search, and claims “*a FASTA opt score greater than 109.*” However, the specification does not describe how to interpret the values from the FASTA search, and specifically how to interpret the significance of the 109 value. See page 12, lines 1-18 of the specification. Claim 36 refers to FASTA opt score *greater than 109* when compared with SEQ ID NO:1. However, the specification lists only different FASTA opt scores that are greater than: 109, 110, 115, 117, 119, 120, 130, 140, and 150; where 150 is the last given value. See page 12, lines 1-18. Claim 36 encompasses any value larger than 109, and thus the specification does not clearly allow persons of ordinary skill in the art to recognize that the Applicant invented what is claimed.

The Applicant’s argument states that the FASTA analysis is well known in the art and that the skilled person in the art would know that the higher the FASTA opt score the higher the percentage identity between the sequences being compared.

Examiner respectfully disagrees with the Applicant and maintains the rejection of Claim 36 because the examiner cannot perform a proper search using the USPTO search databases, and thus the examiner cannot accurately, diligently and correctly perform an adequate evaluation and interpretation of the claim at issue. Thus, Claim 36 is unsearchable and therefore unpatentable under the current status.

New Rejections

35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1, 3, 14, and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 36 is rejected because it uses a Trademark name: "FASTA," and Trademark names are unpatentable.

In Claim 1, the sequence identification should be changed to SEQ ID NO:1.

In Claim 3, the sequence identification should be changed to SEQ ID NO:2.

In Claim 14, the sequence identification should be changed to SEQ ID NO:54 to 59.

In Claim 36, the sequence identification should be changed to SEQ ID NO:1.

35 USC § 102(b)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Tailor et al., "Identification and characterization of a novel *Bacillus thuringiensis* δ -endoxin entomocidal to coleopteran and lepidopteran larvae, Mol. Microbiol., (1992), 6, 1211-1217.

Tailor et al. disclose amino acid sequence that is 100% identical to the SEQ ID NO :55. See Figure 2, page 1213.

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Shin et al. "Distribution of cryV-Type Insecticidal Protein Genes in *Bacillus thuringiensis* and Cloning of cryV-Type Genes from *Bacillus thuringiensis* subsp. *kurstaki* and *Bacillus thuringiensis* subsp. *entomocidus*, Appl. Environ. Microbiol., (1995), 61, p. 2402-2407.

Shin et al. discloses amino acid sequence that is 100% identical to the SEQ ID NO:56 and SEQ ID NO:59. See Figure 3, page 2405.

Conclusion

No claims are allowed.


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SEQ ID NO:1 and SEQ ID NO:2 are free of art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnes Rooke whose telephone number is 571-272-2055. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0925.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR or Public PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR


KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER